



Response Under 37 C.F.R. 1.116 (After Final)
Expedited Procedure Examining Group 3679

Attorney Docket Number: OMG/129/US

12/9/03
LJW
S-16-03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of

Hubert T. McGovern and Thomas P. Druschel

Serial No.09/923,288

Examiner: Jori Schiffman

Group Art Unit: 3679

Filing Date: August 6, 2001

For: DECK SCREWS SUITABLE FOR USE WITH COMPOSITE LUMBER

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GROUP 3600

Sir:

RESPONSE TO OFFICE ACTION (AFTER FINAL REJECTION)

(AMENDMENT UNDER 37 C.F.R. 1.116)

*Do not enter
5/16/03*

In response to the Office Action dated March 10, 2003, Applicants respectfully request entry and consideration of the following Request to Withdraw Finality, Amendment, and Remarks.

**R sponse Under 37 C.F.R. 1.116 (After Final)
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Attorney Docket Number: OMG/129/US

**REQUEST TO WITHDRAW FINALITY AND TO CONSIDER THE ENCLOSED
RESPONSE**

This Request to Withdraw Finality is necessitated by the following:

1. Applicants filed a Response to Office Action on December 4, 2002, which included a "teaching away" argument on page 12 with regard to claims 10, 21, 31, 34, 35, 42, 43, 68, 80, 94, and 106, and a "lack of motivation or suggestion to modify" argument on page 17-18 with regard to claims 36-40, 44, 69-73, 81-86, 93, 95-99, 107-112, and 119.
2. Examiner Schiffman, who issued the Final Rejection, clearly failed to address the entirety of Applicants' arguments filed in the Response to Office Action on December 4, 2002.
3. The Examiner at page 10, ¶ 16 of the Final Office Action states that "[a]pplicants other arguments have been considered but are all (emphasis added) based upon the main argument that Hsing fails to disclose "a shaft...". The Examiner therefore only addressed Applicants' argument with regard to "all claimed elements not present in the proposed modification".
4. The "Final Rejection" does not comport with the requirements for a final action.

The Examiner's attention is respectfully directed to the following sections/passages from 37 C.F.R. and the MPEP laying out the standards applicable to a final rejection:

37 C.F.R. §1.104 Nature of Examination

(a) Examiner's action. (1) On taking up an application for examination or a patent in a reexamination proceeding, the Examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention. The examination shall be complete with respect both to compliance of the application or patent under reexamination with the applicable statutes and rules and to the patentability of the invention as claimed, as well as with respect to matters of form, unless otherwise indicated.

MPEP §706.07 Final Rejection

Before final rejection is in order a clear issue should be developed between the Examiner and Applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the Applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first Office Action and the references fully applied...

The Applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the Examiner to that end, and not be prematurely cut off in the prosecution of his or her case... The Examiner should never lose sight of the fact that in every case the Applicant is entitled to a full and fair hearing, and that a clear issue between Applicant and Examiner should be developed, if possible, before appeal ...

In making the final rejection, all outstanding grounds of rejection of record should be carefully reviewed, and any such grounds relied on in the final rejection should be reiterated. They must also be clearly developed to such an extent that Applicant may readily judge the advisability of an appeal unless a single previous Office Action contains a complete statement supporting the rejection...

37 C.F.R. §1.113 Final rejection or action.

(b) In making such final rejection, the Examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the case, clearly stating the reasons therefor.

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Basis for Request to Withdraw Final Rejection

The second (final) rejections of Applicants' claims fail to meet the statutory and regulatory standards governing patent examination since the entirety of Applicants' arguments were not considered. The current Office Action is therefore incomplete and finality has been imposed prematurely. In particular, Examiner Schiffman did not address Applicants' argument, present on pages 12 of the Response to Office Action, with respect to "teaching away" in support of claims 10, 21, 31, 34, 35, 42, 43, 68, 80, 94, and 106. This is clear from the Examiner's statement that "[a]pplicants other arguments have been considered but are all (emphasis added) based upon the main argument....". Additionally, Examiner Schiffman did not address Applicants' argument, present on pages 17-18 of the Response to Office Action, with respect to a "lack of motivation or suggestion to modify" argument in support of claims 36-40, 44, 69-73, 81-86, 93, 95-99, 107-112, and 119.

The final rejection therefore impermissibly ignores proper argumentation by the Applicants asserting that a *prima facie* case obviousness has not been established.

A final rejection that fails to comply with all relevant rules and regulations impose an undue burden on the Applicants. Non-compliant rejections that are made final unfairly restrict the Applicants' ability to respond because the issues of patentability are not adequately developed in accordance with the standards expressed in the MPEP, 37 C.F.R and 35 U.S.C. Applicants presented with a non-compliant final rejection are unable to judge the advisability of an appeal because the Office Action does not contain a complete statement supporting the rejection. A non-compliant final rejection also prematurely cuts off the prosecution without giving the Applicants a full and fair hearing.

For all the foregoing reasons, Applicants respectfully request consideration of the following amendment and remarks. Should the Examiner find Applicants' response insufficient to overcome the rejection, it is requested that the Examiner issue a detailed, non-final Office Action clearly stating the reasons for the rejection of each claim in view of the prior art.



TRANSMITTAL FORM

Application Number	09/923,288
Filing Date	August 6, 2001
First Named Inventor	Hubert T. McGovern
Title	Deck Screws Suitable For Use With Composite Lumber
Group Art Unit	3679
Examiner Name	Jori Schiffman
Attorney Docket Number	OMG/129/US

ENCLOSURES

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- Response to Office Action (After Final Rejection) (Amendment Under 37 C.F.R. 1.116) Preliminary Amendment MAY 14 2003
- Information Disclosure Statement Postcard Reflecting Enclosures GROUP 3600
- Other:
- It is hereby petitioned that any required extension of time be granted for filing the amendment. An extension of -0- month(s) having a fee of \$ -0- appears required.
- A check in the amount of \$ -0- is attached. Please credit any overpayment to Deposit Account 16-2563 of Alix, Yale & Ristas, LLP.
- The Commissioner is hereby requested and authorized to charge Deposit Account 16-2563 of Alix, Yale & Ristas, LLP for any fee under 37 C.F.R. 1.16 or 37 C.F.R. 1.17 required during the pendency of this application. A duplicate copy of this sheet is attached.

SIGNATURE OF APPLICANT, ATTORNEY OR AGENT

Firm or Individual name

Guy D. Yale

Signature

Date

5-7-2003

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited on the date below with the United States Postal Service as First Class Mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450".

Typed or Printed Name

Guy D. Yale

Reg. No.

29,125

Signature

Date:

5-7-2003